

Appl. No. 09/616,652
Amdt. Dated September 28, 2004
Reply to Office action of April 14, 2004

ARGUMENTS/REMARKS

Applicants would like to thank the Examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office action, and amended as necessary to more clearly and particularly describe and claim the subject matter which applicants regard as the invention.

Claims 1-43 remain in this application.

The Examiner has made this rejection final, despite the fact that the claims were rejected under new grounds (the addition of the Hiroya reference). The Examiner states that the rejection was made final because applicant filed an IDS under CFR 1.97(c) with the fee set forth on 37 CFR 1.17(p), and that this prompted the new grounds of the rejection, making the rejection final. The Examiner cites MPEP §609(B)(2)(i) in support of this final rejection.

Applicant traverses the finality of the rejection. Neither the rules, nor MPEP §609(b)(2)(i), support the Examiner making the rejection final. In fact, the cited MPEP section specifically states that:

If information submitted during the period set forth in 37 CFR 1.97(c) with a *statement* under 37 CFR 1.97(e) is used in a new ground of rejection on unamended claims, the next Office action *will not be made final* since in this situation it is clear that applicant has submitted the information to the Office promptly after it has become known and the information is being submitted prior to a final determination on patentability by the Office

(§609(B)(2)(a)(i) emphasis added). Note that the IDS with the newly utilized Hiroya reference was filed with the *statement* of 37 CFR 1.97(e), and *not* with the fee of 1.97(p) as claimed by the Examiner. The MPEP section quoted above makes clear that an IDS under this scenario cannot be used as the basis for making an action final. This issue was discussed with the Examiner in telephone conversations on September 27 and 28, 2004, where the Examiner agreed to re-address this issue and review the cited MPEP section.

Furthermore, although some claims were amended, it is clear that the amendments did *not* raise new issues because already existing claims contained the elements that were added to the amended claims. For example, claim 1 was

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amended to include elements that were already found in claim 38. Further, claim 38 was also rejected under the new grounds, despite having merely editorial amendments. Thus, the amendments of claims 1 and 38 could not be grounds for making the rejection final because the amendments do not raise new issues. Consequently, the finality of the rejection is not proper and should be withdrawn by the Examiner.

Claims 1-41 were rejected under 35 U.S.C. §103(a) as being unpatentable over Hiroya *et al.* (U.S. 5,754,654) and Sasmazel *et al.* (U.S. 6,032,260) in view of Cogger *et al.* (U.S. 6,032,184). For the following reasons, the rejection is respectfully traversed.

First, the Examiner has apparently ignored the two new claims 42 and 43 that were added to this case by the last amendment. Applicant assumes that they, too, are rejected under these grounds.

Claim 1, as amended, recites both an "electronic ticket" element and a "network electronic ticket" element. The "electronic ticket" is for "providing a customer access to a commodity or a service or admission to an event from a provider" whereas the "network electronic ticket" is for "providing the customer access to access limited online information about the commodity or service or the event from an information providing apparatus on a network". The references, even if combined, do not teach these elements of the claim as limited by the explicit claim language.

The Examiner cites an encrypted "hash number" of Sasmazel as teaching the "network electronic ticket" of claim 1. However, claim 1 explicitly requires that the "network electronic ticket" be for "providing the customer access to online *information about the commodity or service or the event* from an information providing apparatus on a network. It is not enough to just provide information, the claim language clearly requires that the information be about the item being accessed by the use of the

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electronic ticket. The two items are explicitly related.

But because Sasmazel does not discuss any commodity, service, or event, it cannot teach providing access to information *about* the commodity, service, or event that it is silent about. Thus, Sasmazel clearly does not suggest the network electronic ticket as limited by the claim language.

Further, neither Hiroya nor Cogger suggest any network electronic ticket. Thus, the combination of references does *not* teach all of the claim limitations, as required by MPEP §2143.03 (the combination of prior art reference(s) must teach or suggest *all* of the claim elements and/or claim limitations for an obviousness rejection), and thus even if combined, the references do not teach all of the explicitly recited claim limitations.

Finally, the Examiner has still failed to support a prima facie case of obviousness. The burden is on the Examiner to make a prima facie case of obviousness (MPEP §2142). To support a prima facie case of obviousness, the Examiner must show that there is some *suggestion* or *motivation* to modify the reference (MPEP §2143.01). The mere fact that references *can* be combined or modified, alone, is not sufficient to establish prima facie obviousness (*Id.*). The prior art must also suggest the *desirability* of the combination (*Id.*). The fact that the claimed invention is within the *capabilities* of one of ordinary skill in the art is not sufficient, by itself, to establish prima facie obviousness (*Id.*).

Instead, in response to being challenged on this point in previous responses, the Examiner merely again lists benefits found in each of the references for practicing that reference. This is hardly a motivation to combine the reference with another reference. Such an interpretation of motivation would make every reference self-motivating, because all references teach some benefit!

For example, the Examiner states that it would be obvious to modify the Hiroya reference to add practices taught by the Sasmazel reference because "this would prevent a trouble on whether the electronic money and the electronic ticket

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are given or received actually". Besides being poor English, the statement is nothing more than a generalized summary of the benefits taught by Sasmazel.

Further, the statement is not even related to the purpose of the network electronic ticket as recited in claim 1, which is to provide information about a commodity, service, or event that has been, is being, or will be accessed by the electronic ticket. There is nothing in this claim language that is related to preventing "trouble", and thus, even if one were motivated for the reason discussed by the Examiner, one would not arrive at the invention by such motivation, because that motivation would not lead to any modification to provide *information* as in the claimed invention.

Likely recognizing this problem, the Examiner attempts to add an additional motivation for providing the online information discussed above. The Examiner states that Cogger discloses a Web based customer care in which a "trouble ticket or electronic ticket has been used for allowing a customer to remotely access a service provider" and that it would have been "obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of Hiroya and Sasmazel by including the limitation above as taught by Cogger because this would allow the customer to access and display the online information".

But Cogger was not cited for teaching the network electronic ticket. Instead, Cogger teaches that a "trouble ticket" is generated when a user requests a service. (see passages cited in the Office action). The "trouble ticket" is in response to a service request, but is not in response to an electronic ticket. See Figs. 5 and 12. The "trouble ticket" of Cogger is nothing more than a way to track the progress of the service request. It is not used to obtain access limited information *about* a commodity, service, or event that is accessed using an electronic ticket.

One skilled in the art would not be motivated to add the "trouble ticket" feature of Cogger to the other references because none of the other references are concerned with tracking the performance of a service request, and Cogger is not

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concerned with using an electronic ticket for access to a service, commodity, or an event. Thus, there is no motivation for the combination.

Accordingly, for this reason, the rejection cannot stand and should be withdrawn, thus making claim 1 patentable over the references for this reason as well.

Claims 2-16, which depend, directly or indirectly, on claim 1, are patentable for the same reasons, as well as for the limitations contained therein.

Claim 17 recites limitations similar to those discussed for claim 1, and thus claim 17 is also patentable over the references for the same reasons discussed for claim 1. Claims 18-36, which depend, directly or indirectly on claim 17, are all patentable over the references for the same reasons as claim 17 (as well as for the limitations contained therein).

Claims 38 and 39 also contain limitations similar to those of claim 1, and thus those claims are patentable over the reference for the same reasons discussed for claim 1, above.

Further, claim 39 recites a "mobile user terminal for communicating with the service server for purchasing the networked-linked electronic ticket" (lines 13-15) an "information server for communicating with the mobile user terminal for checking the network electronic ticket before providing information to the mobile user terminal via the public network" (lines 16-19) and a

"gate terminal for communicating with the mobile user terminal and for automatically checking the electronic ticket before providing the customer access to the commodity, the service, and/or user admission to the event"

(lines 20-25). The Examiner has repeatedly failed to address these claim limitations, despite being reminded of them in prior office actions. Claims 40 and 41, being directly or indirectly dependent on claim 39, are patentable for the same reasons as claim 39 (as well as for the limitations contained therein).

Claims 42 and 43 contain one or more limitations similar to those discussed above, and thus are patentable for the same reasons as discussed herein.

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In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 32808.

Respectfully submitted,
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